

**REMARKS**

**Status of Claims:**

Claims 1-27, 29, and 31 remain cancelled without prejudice or disclaimer. Claims 46-66 and 68-69 remain withdrawn. Thus, claims 28, 30, 32-45, 67, and 70-78 are present for examination.

Applicant expresses appreciation to the Examiner (Mr. Naff) for the courtesy of conducting a telephone interview with the undersigned on March 20, 2006. In the telephone interview, the rejections of claims 32 and 70 under 35 U.S.C. 112, first paragraph, were discussed. In particular, the undersigned emphasized the remarks provided below, regarding the rejection of those claims. The Examiner stated that he would re-consider the rejections of those two claims, in view of those remarks.

**Claim Rejection under 35 U.S.C. 112, first paragraph:**

Claims 32-34, 36, 37, 39, 40 and 70 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner stated that "the specification supports only an invention requiring the active protein in solidified form to be sufficiently immobilized to minimize swelling and shrinkage" and suggested that claim 32 be amended as claims 28 and 71, to recite sufficient immobilization to minimize swelling that would deform the shape of the sensor body and shrinkage that would create voids between the active protein in solidified form and the sensor body.

Applicant respectfully disagrees with the Examiner because the specification provides sufficient support for operability and advantages of embodiments of the invention that relate to an active protein in solidified form (even without the recitation of sufficient immobilization to minimize swelling and shrinkage). By receiving the hardened (solidified) protein in the sensor, while the protein is in a solidified form, improvements in ability to have a protein maintain a desired shape, mechanical stability, longevity, a proper fit within the sensor body and ease of

inserting the protein into the sensor body can be achieved (see, e.g., page 3, lines 5-10; page 6, lines 10-12; page 10, lines 20-22; and page 17, lines 3-11 of the specification). Thus, while embodiments may provide advantages with respect to minimization of swelling and shrinkage, other embodiments may employ a hardened or solidified form of the protein to provide other significant advantages, such as those listed above (regardless of the ability to minimize swelling and shrinkage).

In addition, it is noted that claims of the originally filed application referred to a hardened active protein, but did not recite that the active protein is sufficiently immobilized to minimize swelling and shrinkage. Accordingly, it is submitted that the application, itself, shows that the present inventors had *possession* of the subject matter recited in claim 32

Accordingly, the rejection of claims 32-34, 36, 37, 39 and 40 under 35 U.S.C. 112, first paragraph, is respectfully traversed.

With respect to claim 70, the Examiner stated that it was not readily apparent where the specification recites the shapes included in the claim. The Examiner requested that the Applicant point out the page and line where these shapes are disclosed. In response, it is submitted that examples of the shapes recited in claim 70 are described in the paragraph bridging pages 13 and 14 of the specification (and, in particular, page 13, lines 21-23 refers to "semicylindrical," and page 14, lines 1-2 refer to cylindrical, tubular and spherical mold shapes for molding protein pellets of those desired shapes). The specification describes the ultimate shape of the protein as being defined by the mold. (e.g., see page 14, lines 8-10 of the specification.) Accordingly, it is submitted that the subject matter of claim 70 is supported by the written description and the objection to claim 70 is, therefore, respectfully traversed.

**Claim Rejection under 35 U.S.C. 112, second paragraph:**

Claims 67 and 74-76 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. With regard to claim 67, the Examiner suggested removal of the phrase "that is hard enough to maintain its shape without external forces." Claim 67 is amended, as suggested by the Examiner to remove that phrase.

With regard to claims 74-76, the Examiner stated that the phrases "a recess", "a block" and "a mold" are confusing and unclear, because claim 71 refers to those elements. In response, claims 74, 75 and 76 are amended herein to refer to "*the* recess", "*the* block" and "*the* mold" (as antecedent references to the recess, block and mold recited in claim 71).

Accordingly, the objection to claims 67 and 74-76 is believed to be overcome. Withdrawal of the objection is requested.

**Conclusion:**

Applicant notes with appreciation the Examiner's indication that claims 28, 30, 35, 38, 41-45, 71-73, 77 and 78 are allowable and that claims 32-34, 36, 37, 39, 40, 67, 70 and 74-76 are "free of the prior art." Those claims remain in the application (with amendments noted above, to address the objections raised by the Examiner).

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date: March 24, 2006

FOLEY & LARDNER LLP

Customer Number: 23392

Telephone: (310) 975-7963

Facsimile: (310) 557-8475

By: 

Ted R. Rittmaster

Attorney for Applicant

Registration No. 32,933